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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,021	06/08/2000	TOSHIYA TAKEKUMA	21776-00050	9733
30678 7590 09/16/2009 CONNOLLY BOVE LODGE & HUTZ LLP 1875 EYE STREET, N.W. SUITE 1100 WASHINGTON, DC 20006				
EXAMINER				
GORT, ELAINE L				
ART UNIT		PAPER NUMBER		
3687				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/581,021

**Applicant(s)**

TAKEKUMA ET AL.

**Examiner**

Elaine Gort

**Art Unit**

3687

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 71-89 is/are pending in the application.
- 4a) Of the above claim(s) 71-78, 80-85 and 87-89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 79 and 86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 71-78, 80-85, and 87-89 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/2/09. Examiner notes that Applicant indicated that these claims are canceled but no appropriate listing of the claims was presented showing they are cancelled.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 79 and 86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear in claim 79 line 11 if "selling information" is referring to a second set of selling information, or referring to the selling information recited in line 4.

It is unclear in claim 79 line 11 if "addresses of sellers" is referring to a second set of addresses of sellers, or referring to the addressed of sellers recited in line 4.

It is unclear in claim 79 line 12 if "addresses of buyers" is referring to a second set of addresses of buyers, or referring to the addresses of buyers recited in line 5.

It is unclear in claim 79 line 12 if "information on distribution costs" is referring to a second set of information on distribution costs, or referring to the information on distribution costs recited in line 7.

It is unclear in claim 79 line 15 if "plural pieces of selling information" is referring to a second set of plural pieces of selling information, or referring to the plural pieces of selling information recited in line 11.

Claim 79 recites the limitation "The calculated total amounts" in line 18. There is insufficient antecedent basis for this limitation in the claim.

It is unclear in line 9 regarding transmitting means. It is unclear if the transmitting means is for obtaining selling information or obtaining plural pieces of information, or for calculating buying costs. It is further unclear what part of the apparatus is carrying out the obtaining plural pieces of selling information and calculating the total buying costs. The claim seems to be a hybrid of apparatus and method steps and is indefinite.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 79 and 86, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Patent 5,794,207) in view of Cameron et al. (5,592,378).

Walker et al. discloses the claimed goods dealing apparatus/article of manufacture for buying and selling goods by pre-engagement connected to plural seller's terminal devices and plural buyer's terminal devices through a computer network (see Walker et al. abstract disclosing an Internet system for taking multiple buyer's binding purchase offers and matching these offers to multiple sellers to form binding sales contracts, see also figure 1 showing the networked system.), comprising:

First storage means for storing selling information and addresses of sellers received from said plural seller's terminal devices (such as sellers goods sold and electronic e-mails of sellers, col 12, line 10+) and buying information and addresses of buyers received from said plural buyer's terminal devices (buyer's information such as past system usage, tracking numbers of CPOs, and addresses, column 13 lines 1+);

Transmitting means for, in response to a request for obtaining selling information received from said buyer's terminal devices (buyer for example submits a CPO to obtain selling information such as negotiate a sale), obtaining plural pieces of selling information, plural addresses of sellers (column 18 lines 26+ potential sellers elect to receive all CPO's in their subject area via e-mail) and addresses of buyers from said first storage means

***but is silent regarding:***

second storage means for storing information on distribution costs between two points in accordance with a quantity of shipment;

the storage and use of plural addresses of buyers;

obtaining plural pieces of information on distribution costs from said second storage means; and

calculating total buying costs including distribution costs corresponding to plural pieces of selling information based on said plural pieces of selling information obtained from said first storage means and said plural pieces of information on distribution costs obtained from said second storage means, and then transmitting the calculate total amounts to said buyer's terminal devices.

Cameron et al. teaches that it is old and well known in the art of on-line purchasing to access and obtain stored information on distribution costs between two points in accordance with a quantity of shipment to provide buyers with shipping cost information (for example see figure 28, 29 and column 18 lines 10+); the entry of plural addresses of buyers so shipments can be made to multiple addresses and shipping costs can be calculated at the same time (column 18 lines 24+); and calculating total buying costs including distribution costs corresponding to plural pieces of selling information based on plural pieces of selling information and plural pieces of information on distribution costs obtained from said second storage means, and then transmitting the calculated total amounts to said buyer's terminal devices (for example see figure 25) to provide purchasers with purchasing options that incorporate shipping and handling.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the apparatus of Walker et al. with the storing and obtaining of distribution costs; storage and use of plural addresses of buyers; calculating of total buying costs including distribution costs corresponding to plural pieces of selling information based on said plural pieces of selling information and said plural pieces of information on distribution costs; and transmitting the calculated total amounts to said buyer's terminal devices as taught by Cameron et al. in order to provide buyers with detailed costs including shipping for orders with multiple addresses of shipment.

Functional recitation(s) used in apparatus claims (e.g. "in response to a request for obtaining selling information received from said buyer's terminal devices, obtaining plural pieces of selling information, plural addresses of sellers and plural addresses of buyers from said first storage means, and obtaining plural pieces of information on distribution costs from said second storage means, calculating total buying costs including distribution costs corresponding to plural pieces of selling information based on said plural pieces of selling information obtained from said first storage means and said plural pieces of information on distribution costs obtained from said second storage means, and then transmitting the calculate total amounts to said buyer's terminal devices" as recited in claim 79) are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963)

### ***Response to Arguments***

5. Applicant's arguments filed Applicant's arguments with respect to claims 79 and 86 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is 571/272-6781. The examiner can normally be reached on Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Gart can be reached on 571/272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/  
Primary Examiner, Art Unit 3687

Elaine Gort  
Primary Examiner  
Art Unit 3687

September 11, 2009